

REMARKS

Claims 1, 2, 4 and 5 remain in the case.

Claims 1, 2 and 4 have been amended in response to the office action.

Reconsideration of this Application is requested.

No new matter has been entered.

REJECTIONS UNDER 35 U.S.C. § 102, SECOND PARAGRAPH

The Examiner has rejected claims 1, 2, 4 and 5 as being anticipated by **Mainville**, US Patent No. 6,938,538 ("the '538 Patent") under 35 U.S.C. § 102(b).

The Applicant respectfully traverses the rejection. **Mainville** should be withdrawn as not proper prior art under any part of 35 U.S.C. Section 102. The '538 Patent issued on September 6, 2005, and was not earlier published, while the present application was filed on January 6, 2004. As shown in the attached declaration filed under 37 C.F.R. Section 1.132, the sole inventor of the '538 Patent, Luc Mainville, is also the sole inventor in the present application, and both are assigned to the same assignee.

In view of the above and foregoing, it is respectfully requested that the Examiner withdraw her rejection of claims 1, 2, 4 and 5 on the basis of the '538 Patent under 35 U.S.C. § 102, second paragraph.

REJECTIONS UNDER 35 U.S.C. § 103, FIRST PARAGRAPH

The Examiner has rejected claims 1, 2, 4 and 5 as being unpatentable over **Notenboom**, under 35 U.S.C. § 103, first paragraph.

The Applicant respectfully traverses this rejection as well. With this amendment, Applicant has amended claims 1, 2 and 4 to more clearly recite the invention, specifically by clarifying that each piston head comprises a bore seal, each bore seal providing a sealing wall, between successive areas where the fluid is present on one side of the second end, and areas where the fluid is absent on one side of the

first end, as supported in the description portion of the application as filed. Claim 5, defining a bore seal confining the fluid on a side of the hydraulic inlet port, already recites this feature.

Notenboom, to the contrary, teaches a double acting telescoping hoist, i.e. an open assembly, made of open ended steel alloy tubes 1, 2, 3, 4 and 5 (see column 2, lines 62-63), the lower open end of each tube being capped with a piston 8-11, the pistons defining between them expansion chambers 15-19 in fluid communication with an external fluid source, the upper end of each tube being capped by a header 21-24 defining retraction chambers 26-29 in fluid communication with an external fluid source (see column 2, lines 63-71), so that fluid is present on both sides (our emphasis).

Piston rings 43 and 45 pointed out by the Examiner form a fluid seal for the retraction chambers 26-29 beneath the pistons (see column 3, lines 22-27). Wiper strips 47 pointed out by the Examiner create a seal in headers 21-24 to prevent foreign objects from getting inside the hoist (see column 3, lines 28-29) and seals 42 pointed out by the Examiner, in the headers, create fluid seals for the upper end of the retraction chambers 26-29.

Notenboom does not hint at a bore seal telescopic hoist as recited in the amended claims 1, 2, 4, and in present claim 5.

In the present invention, air is aspirated in and pushed out, by an end opposite the end provided with the hydraulic inlet port 28, U-shaped cup bore seals 42, 46 and 50 providing a sealing wall between areas reached by air, and areas where fluid is present (our emphasis), while allowing formation of a film of fluid on sliding walls on the telescopically arranged and moving tubular sections (see paragraph 0018), thereby assuring a lubricated contact therebetween.

In view of the above and foregoing, it is respectfully requested that the Examiner withdraw her rejection of claims 1, 2, 4 and 5 under 35 U.S.C. § 103(a).

The rejections of the claims are believed to have been overcome by the amendments and remarks presented herewith. From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such an action is earnestly solicited.

Respectfully submitted,

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